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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

ZECHER, MICHAEL R

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/685,583	Applicant(s) SILVERBROOK ET AL.	
	Examiner MICHAEL R. ZECHER	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,17,21-23 and 25-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-16, 18-20, & 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/7/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a final Office Action on the merits. The Amendment/Remarks received on November 27, 2008, have been entered. The Terminal Disclaimer filed November 27, 2008, has been entered and approved. **Claims 2, 3, 17, 21-23, & 25-38** have been cancelled. **Claims 1, 4-8, 11, 14, 18, & 24** have been amended. **Claims 1, 4-16, 18-20, & 24** are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1 & 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gott (U.S. 4,088,981) (hereinafter "Gott"), and further in view of Morishita et al. (U.S. 6,335,727) (hereinafter "Morishita").

As per claim 1, Gott teaches a method of initiating a banking transaction, the method including the steps of:

providing a banking customer with a printed banking form including first printed coded data identifying a form identity and a plurality of first locations and second printed coded data identifying the form identity and a plurality of second locations (figure 1, col. 2, lines 9-35, and col. 2, line 65 through col. 3, line 53);

transmitting data from the pen to the computer system, such that the computer system can identify, from said data, the identity of the banking form, the identity of the

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banking customer, and the first and second parameters, and thereby initiate the banking transaction (abstract, figure 1, col. 5, line 59 through col. 6, line 2).

Gott does not disclose:

interacting with a first zone of the printed form containing the first coded data using an optically imaging pen, said first zone being associated with a first parameter of the banking transaction;

interacting with a second zone of the printed form containing the second coded data using the optically imaging pen, said second zone being associated with a second parameter of the banking transaction;

generating, in the pen, data, regarding identity of the form, the identity of the banking customer, at least one first location within said first zone and at least one second location within said second zone.

Morishita discloses an input information device that includes an information holding device and positional recognition system (abstract).

Both Gott and Morishita disclose providing a means for data entry, such as inputting transactional data. Morishita teaches a sensing device that can recognize coded data and generate data regarding the at least one parameter and movement of the sensing device relative to the coded data (figure 2, col. 5, lines 5-25 and lines 45-57, col. 6, lines 31-51 and col. 11, line 40-col. 12, line 10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gott with the teachings of Morishita because such a modification would allow Gott to have an input device that is capable of reading and sensing coded data on a financial form.

Claim 24 recites equivalent limitations to claim 1 and is therefore rejected using the same art and rationale set forth above.

3. **Claims 4 & 6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gott (U.S. 4,088,981) (hereinafter "Gott"), in view of Morishita et al. (U.S. 6,335,727) (hereinafter "Morishita"), and further in view of Dymetman et al. (U.S. 6,330,976) (hereinafter "Dymetman").

As per claim 4, the combination of Gott and Morishita does not disclose wherein at least one of said first and second parameters is an action parameter of the banking transaction, the method including initiating, in the computer system, an operation in respect of the at least one parameter.

Dymetman discloses a marking medium area with encoded identifier for producing action through a network (abstract).

Gott, Morishita, and Dymetman disclose providing a means for data entry, such as inputting transactional data. Dymetman teaches wherein at least one of said first and second parameters is an action parameter of the banking transaction, the method including initiating, in the computer system, an operation in respect of the at least one parameter (col.4, lines 16-23). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the disclosures of Dymetman in the combination of Gott and Morishita. The combination taken as a whole suggests that in order to perform a banking transaction a form needs to be provided to collect and to process the information relating to the financial transaction.

As per claim 6, the combination of Gott and Morishita fails to disclose wherein at least one of said first and second parameter is an option parameter of the banking transaction, the method comprising initiating, in the computer system, an operation associated with the option parameter.

Dymetman teaches wherein at least one of said first and second parameter is an option parameter of the banking transaction, the method comprising initiating, in the computer system, an operation associated with the option parameter (col. 30, line 65- col. 31, line 39). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the disclosures of Dymetman in the combination of Gott and Morishita. The combination taken as a whole suggests that in order to perform a banking transaction a hand-drawn mark (i.e. signature) needs to be made in order to identify the acceptance of the information on the form by a person relating to the financial transaction.

4. **Claims 5 & 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gott (U.S. 4,088,981) (hereinafter "Gott"), in view of Morishita et al. (U.S. 6,335,727) (hereinafter "Morishita"), in view of Dymetman et al. (U.S. 6,330,976) (hereinafter "Dymetman"), and further in view of Richards et al. (U.S. 6,539,361) (hereinafter "Richards").

As per claim 5, the combination of Gott, Morishita, and Dymetman does not disclose that the action parameter of the banking transaction is selected from the group consisting of: a request for information relating to banking services, an order for checks, a request to stop checks, an application for a new account, an application for a loan, a

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request for an account history, a request for a withdrawal of funds, a request for a transfer of funds, a request for an account balance, a payment of a bill, and a request for a list of bill payments.

Richards discloses a method of automated banking (abstract).

Gott, Morishita, Dymetman, and Richards disclose providing a means for data entry, such as inputting transactional data. Richards teaches that the action parameter of the banking transaction is selected from the group consisting of: a request for information relating to banking services, an order for checks, a request to stop checks, an application for a new account, an application for a loan, a request for an account history, a request for a withdrawal of funds, a request for a transfer of funds, a request for an account balance, a payment of a bill, and a request for a list of bill payments (col. 1, lines 26-44). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the disclosures of Richards in the combination of Gott, Morishita, and Dymetman. The combination taken as a whole suggests that in order to perform a banking transaction a request for certain services needs to be provided in order to receive the requested banking services.

As per claim 7, the combination of Gott, Morishita, and Dymetman does not disclose wherein the option parameter is associated with at least one of: a request for information relating to banking services, an order for checks, a request to stop checks, an application for a new account, an application for a loan, a request for an account history, a request for a withdrawal of funds, a request for a transfer of funds, a request

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for an account balance, a payment of a bill, a request for a list of bill payments, an account, a currency, and a payee name.

Richards teaches wherein the option parameter is associated with at least one of: a request for information relating to banking services, an order for checks, a request to stop checks, an application for a new account, an application for a loan, a request for an account history, a request for a withdrawal of funds, a request for a transfer of funds, a request for an account balance, a payment of a bill, a request for a list of bill payments, an account, a currency, and a payee name (col. 1, lines 26-44). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the disclosures of Richards in the combination of Gott, Morishita, and Dymetman. The combination taken as a whole suggests that in order to perform a banking transaction a request for certain services needs to be provided in order to receive the requested banking services.

5. **Claims 8-12 & 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gott (U.S. 4,088,981) (hereinafter "Gott"), in view of Morishita et al. (U.S. 6,335,727) (hereinafter "Morishita"), and further in view of Patterson, Jr. et al. (U.S. 5,797,002)(hereinafter "Patterson, Jr.").

As per claim 8, the combination of Gott and Morishita does not disclose wherein at least one of the first and second parameters is a text parameter of the banking transaction, the method including initiating, in the computer system, an operation associated with the text parameter.

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Patterson, Jr. discloses a computer-based technique for transferring financial orders, quotes, and memos (abstract).

Gott, Morishita, and Patterson, Jr. disclose providing a means for data entry, such as inputting transactional data. Patterson, Jr. teaches wherein at least one of the first and second parameters is a text parameter of the banking transaction, the method including initiating, in the computer system, an operation associated with the text parameter (fig. 4, 8, & 11, and col. 13, line 20-col. 15, line 55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the disclosures of Patterson, Jr. in the combination of Gott and Morishita. The combination taken as a whole suggests that in order to identify a customer, the handwriting needs to match in order to be converted to computer text.

As per claim 9, the combination of Gott and Morishita does not disclose converting, in the computer system, the handwritten text data to computer text.

Patterson, Jr. teaches converting, in the computer system, the handwritten text data to computer text (fig. 4, 8, & 11, and col. 13, line 20-col. 15, line 55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the disclosures of Patterson, Jr. in the combination of Gott and Morishita. The combination taken as a whole suggests that in order to identify a customer, the handwriting needs to match in order to be converted to computer text.

As per claim 10, the combination of Gott and Morishita does not disclose that the text parameter is associated with at least one of: a check amount, a payee name, a

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currency amount, a transfer amount, a payment amount, a payment date, and a check number.

Patterson, Jr. teaches a check amount, a payee name, a currency amount, a transfer amount, a payment amount, a payment date, and a check number (fig. 4, 8, & 11 and col. 13, line 20 through col. 15, line 55; and, furthermore, these parameters are inherently part of processing and/or writing checks). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the disclosures of Patterson, Jr. in the combination of Gott and Morishita. The combination taken as a whole suggests allowing a checking transaction to be identified.

As per claim 11, the combination of Gott and Morishita does not disclose wherein at least one of the first and second parameters is an authorization parameter of the banking transaction, the method including initiating, in the computer system, an operation associated with the authorization parameter.

Patterson, Jr. teaches wherein at least one of the first and second parameters is an authorization parameter of the banking transaction, the method including initiating, in the computer system, an operation associated with the authorization parameter (fig. 4, 8, & 11, and col. 13, line 20-col. 15, line 55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the disclosures of Patterson, Jr. in the combination of Gott and Morishita. The combination taken as a whole suggests verifying a customer's identification information before processing a financial transaction.

As per claim 12, the combination of Gott and Morishita does not disclose verifying, in the computer system, that the signature is that of the customer.

Patterson, Jr. teaches verifying, in the computer system, that the signature is that of the custom (fig. 4, 8, & 11, and col. 13, line 20-col. 15, line 55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the disclosures of Patterson, Jr. in the combination of Gott and Morishita. The combination taken as a whole suggests verifying a customer's identification information before processing a financial transaction.

As per claim 20, the combination of Gott and Morishita does not disclose retaining a retrievable record of each form generated, the form being retrievable using its identity as contained in its coded data.

Patterson Jr. et al. teaches retaining a retrievable record of each form generated, the form being retrievable using its identity as contained in its coded data (col. 8, line 32 through col. 9, line 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the disclosures of Patterson, Jr. in the combination of Gott and Morishita. The combination taken as a whole suggests maintaining a record of financial transactions in order to properly document accounts and ensure that each respective transaction is proper.

6. **Claim 13** is rejected under 35 U.S.C. 103(a) as being unpatentable over Gott (U.S. 4,088,981) (hereinafter "Gott"), in view of Morishita et al., (U.S. 6,335,727) (hereinafter "Morishita"), and in view of Patterson, Jr. et al. (U.S. 5,797,002)(hereinafter

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“Patterson, Jr.”), and further in view of Richards et al. (U.S. 6,539,361) (hereinafter “Richards”).

As per claim 13, the combination of Gott and Morishita does not disclose that the authorization parameter is associated with authorization for at least one of: access to account information, withdrawal of funds, transfer of funds, payment of a bill, modification of a bill payment, deletion of a bill payment, stopping of checks, and ordering of checks.

Richards discloses enabling customers to dispensing cash, make deposits, transfer funds, etc. (col. 1, lines 26-44). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Gott, Morishita, and Patterson, Jr. combination to include an authorization parameter in a banking transaction comprising a request for dispensing cash, making deposits, transferring funds, etc. as taught by Richards in order to allow banking customer to benefit from using quick and efficient means for processing financial transactions.

7. **Claim 16** is rejected under 35 U.S.C. 103(a) as being unpatentable over Gott (U.S. 4,088,981) (hereinafter “Gott”), in view of Morishita et al, (U.S. 6,335,727) (hereinafter “Morishita”), and further in view of Richards et al. (U.S. 6,539,361) (hereinafter “Richards”).

As per claim 16, the combination of Gott and Morishita does not disclose that the form contains information relating to at least one of: information relating to banking services, an order for checks, a request to stop checks, an application for a new account, an application for a loan, a request for an account history, a request for a

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withdrawal of funds, a request for a transfer of funds, a request for an account balance, a payment of a bill, and a request for a list of bill payments.

Richards teaches that the form contains information relating to at least one of: information relating to banking services, an order for checks, a request to stop checks, an application for a new account, an application for a loan, a request for an account history, a request for a withdrawal of funds, a request for a transfer of funds, a request for an account balance, a payment of a bill, and a request for a list of bill payments (col. 1, lines 26-44). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the disclosures of Richards in combination with Gott and Morishita. The combination taken as a whole suggests that in order to perform a banking transaction a request for certain services needs to be provided in order to receive the requested banking services.

8. **Claims 14-15 & 18-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gott (U.S. 4,088,981) (hereinafter "Gott"), in view of Morishita et al, (U.S. 6,335,727) (hereinafter "Morishita"), and further in view of Official Notice.

As per claim 14, the Gott and Morishita combination does not disclose wherein at least one of the first and second parameters is a picture parameter of the banking transaction, the method including initiating, in the computer system, an operation associated with the picture parameter.

The Examiner takes Official Notice that it is old and well known in the art to have picture parameters associated with a financial transaction that can be identified and associated with a particular operation. Therefore, it would have been obvious to one of

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ordinary skill in the art at the time the invention was made to modify the Gott and Morishita combination to include a picture parameter that may be identified and associated with an operation in order to timely identify a parameter and to minimize the necessary text required to identify an item or document.

As per claim 15, the Gott and Morishita combination does not disclose that the picture parameter is associated with a graphic design for a customer's checks.

The Examiner takes Official Notice that it is old and well known in the art to have picture parameters associated with a financial transaction that can be identified and associated with a particular operation. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Gott and Morishita combination to include a picture associated with a graphic design of a customer's check in order to timely identify an operation and to minimize the necessary text required to identify an item or document.

As per claim 18, the Gott and Morishita combination does not disclose printing the form on a surface and, at the same time that the form is printed, printing the coded data on the surface.

The Examiner takes Official Notice that it is old and well known in the art to print forms on demand and print coded data (i.e. checks). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Gott and Morishita combination to include printing forms on demand, including printing coded data, in order to allow a banking customer access to paper records and enhance security measures by coding relevant financial data.

As per claim 19, the Gott and Morishita combination does not disclose printing the coded data to be substantially invisible in the visible spectrum.

The Examiner takes Official Notice that it is old and well known in the art to print coded data to be substantially invisible (i.e. checks). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Gott and Morishita combination to include printing substantially invisible coded data in order to enhance security measures by masking relevant financial data.

Response to Arguments

9. Applicant's arguments, see pages 9 & 10, filed November 27, 2008, with respect to the 35 U.S.C. § 112, second paragraph, rejection of **claims 1-38** have been fully considered and are persuasive. The 35 U.S.C. § 112, second paragraph, rejection of **claims 1-38** has been withdrawn.

10. Applicant's arguments, see page 10, filed November 27, 2008, with respect to the 35 U.S.C. § 101 rejection of **claims 1-38** have been fully considered and are persuasive. The 35 U.S.C. § 101 rejection of **claims 1-38** has been withdrawn.

11. Applicant's arguments, see page 10 of the Remarks, filed November 11, 2008, with respect to Non-Statutory Double Patenting rejection of **claims 1-38** have been fully considered and are persuasive. The Terminal Disclaimer filed November 27, 2008, has been acknowledged, entered, and approved. The Non-Statutory Double Patenting rejection of **claims 1-38** has been withdrawn.

12. Applicant's arguments with respect to **claims 1, 4-16, 18-20, & 24** have been considered but are moot in view of the new grounds of rejection.

Conclusion

13. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MICHAEL R. ZECHER** whose telephone number is (571)270-3032. The examiner can normally be reached on M-F 7:30-5:00 alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/
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/Michael R. Zecher/
Examiner, Art Unit 3691